

REMARKS

This response is submitted in response to the final Office Action mailed May 28, 2008 ("Office Action"). Claims 25-40 are pending. Claim 25 is independent.

Rejection Under 35 U.S.C. § 103

Claims 25-40 are rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,713,853 to Clark et al. ("Clark") in view of U.S. Patent No. 6,364,856 to Ding et al. ("Ding"). This rejection is respectfully traversed.

Independent claim 25 recites a medical device comprising a "delivery member . . . shaped in a continuous solid cylindrical configuration." As the Examiner conceded, Clark does not disclose a "delivery member . . . shaped in a continuous solid cylindrical configuration." (Office Action at 2.) Rather, as described in the specification and seen in Figures 24-25 of Clark, there are gaps between ribs. For the following reasons, it would not be obvious to a person having ordinary skill in the art to modify the device of Clark to contain a delivery member shaped in a continuous solid cylindrical configuration.¹

As the Examiner has acknowledged, "obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so." (Office Action at 3.) Applicants respectfully submit, however, that in the Office Action, the Examiner has failed to provide such a teaching, suggestion, or motivation. While the Examiner posits that the delivery member of Clark can be replaced with a continuous solid cylindrical delivery member, the Examiner points to no teaching, suggestion, or motivation to do so, whether in the cited references themselves or in the art generally. In fact, not only has the Examiner not provided such a teaching, suggestion, or motivation to modify the device of Clark to have a delivery member shaped in a continuous solid cylindrical configuration, but such a teaching, suggestion, or motivation cannot exist for at least two reasons. First, Clark teaches away from such a modification. Second, such a modification renders Clark unsatisfactory for at least two of its intended purposes.

First, because Clark teaches away from a delivery member shaped in a continuous

¹ Applicants take no position at this time as to whether Ding discloses a delivery member having a continuous solid cylindrical configuration, because Applicants believe that the rejection is improper even if Ding does include such a disclosure. Applicants reserve the right to make more specific arguments related to Ding in the future if the Examiner does not accept Applicants' arguments herein.

solid cylindrical configuration, there is no teaching, suggestion, or motivation to modify Clark to include such a delivery member. "It is improper to combine references where the references teach away from their combination." Manual of Patent Examiner Procedure, 8th Ed. Rev. 6 (Sep. 2007) ("MPEP") § 2145(X)(D)(2); *see also KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1740 (2007); *Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1358-59 (Fed. Cir. 2007) (finding the prior art taught away from the claims and the claims therefore were not invalid). As described in more detail in Applicants' March 5, 2008 response, which Applicants incorporate herein, Clark teaches away from a delivery member shaped in a continuous solid cylindrical configuration for at least two reasons. First, Clark's delivery member is specifically designed to allow blood to flow to tissue distal to the delivery site, thereby increasing the possible length of surgical procedures. Second, the ribs in the delivery member of Clark are intentionally designed to allow the device to serve as a thrombolytic filter. If the device is modified to contain a delivery member with a continuous solid cylindrical configuration without gaps between ribs, it would no longer allow for blood to reach tissue distal the delivery site and would no longer act as a filter. Because Clark teaches away from adding the recited delivery member, there is no teaching, suggestion, or motivation to modify Clark to add such a delivery member. Therefore, the rejection of claim 25 should be withdrawn for at least this first reason.

While Applicants presented this teaching-away argument in their March 5, 2008 response, Applicants respectfully submit that in the Office Action the Examiner did not sufficiently address Applicants' argument. In particular, the Examiner apparently focused on Clark's disclosure of the aspects of Clark's device aside from the delivery member. (*See* Office Action at 3.) That is improper. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP § 2141.02(VI). Despite the express teachings in Clark against adding a delivery member with a continuous solid cylindrical configuration, the Examiner is of the position that the delivery member of Clark's device can be removed and replaced with a delivery member with a continuous solid cylindrical configuration. However, it is improper to ignore those teachings in Clark. When the *entire* reference is considered, as it must be, it is evident that Clark cannot be modified to achieve the invention of claim 25.

Second, there is also no teaching, suggestion, or motivation to combine Clark with a delivery member shaped in a continuous solid cylindrical configuration, because altering

Clark in such a fashion would render Clark unsatisfactory for at least two of its intended purposes. "If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01(V). As stated above, two goals of Clark are to allow blood to flow to tissue distal the delivery site and to have the delivery member serve as a filter. If Clark's delivery member is replaced with a delivery member with a continuous solid cylindrical configuration, neither of these purposes can be achieved. Therefore, it is improper to modify the device of Clark in that fashion, because doing so will render the device inoperable in at least two respects. For at least this second reason, the rejection of claim 25 should be withdrawn.

Consequently, it would not be obvious to one having ordinary skill in the art to modify the device of Clark to contain a delivery member with a continuous solid cylindrical configuration. Therefore, Applicants respectfully request that the rejection of independent claim 25 be withdrawn. Because dependent claims 26-40 depend from independent claim 25, Applicants respectfully request that the rejection of claims 26-40 be withdrawn for at least the same reasons that the rejection of independent claim 25 should be withdrawn.

CONCLUSION

It is believed that claims 25-40 are in condition for allowance. Should the Examiner not agree with any of Applicants' positions or arguments herein, a telephonic or personal interview is respectfully requested to discuss and resolve any remaining issues.

No fee is believed due for this response. Should any fee(s) be due at this time, please charge such fee(s) to Jones Day Deposit Acct. No. 50-3013.

Respectfully submitted,

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